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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,538	11/08/2001	John Rolph	906	9195

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EXAMINER

MAI, TRI M

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,538

Applicant(s)

ROLPH, JOHN

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 12/23/02 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of a cap, and the cap is attached to the portion 38.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cap being attached to the cover in claim 7, the fire resistant nylon must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The amendment filed 12/23/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: inter alia, the retention means further comprises an integrally attached cap, the cap resting on the top surface, the various material as set forth in the amendment, and the material being fire resistant nylon fiber.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure does not teach the cap being integral to the drawstring, and the internal volume comprising fire resistant nylon fiber. This is a new matter rejection.

6. Claims 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation with respect to the internal retention volume comprising fire resistant nylon fiber is incorrect. "An internal volume" is an empty space and it does not contain the fiber.

Claim Rejections - 35 USC § 103

7. Claims 1, and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. (5775722) in view of Spector (5135222). Moore teaches a cover having a cylindrical outer housing 12 closed at the upper end of an upper housing cover 18, and a conduit formed about the lower circumference of the outer housing near the entry of the orifice as shown in Figs. 2, and 3.

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Moore meets all claimed limitations except for the dimension of the cover and the spring clip. It would have been obvious to one of ordinary skill in the art to make the cover in the claimed dimension, since such a modification would have involved a mere change in size and/or proportion. A change in size/proportion is generally recognized as being within the level of ordinary skill in the art. (see *In re Rose*, 105 USPQ 237 (CCPA 1955), and *In re Tanczyn*, 44 CCPA 704, 766, 241).

Furthermore, it would have been obvious to one of ordinary skill in the art to change the size of the cover in Moore to accommodate the desired content.

With respect to the clip, Spector teaches that it is known in the art to provide a spring clip

10. It would have been obvious to one of ordinary skill in the art to provide a spring clip in Moore as taught by Spector to close the bag easily.

Regarding claims 3-4, the materials (col. 2, lines 25-26) are light impenetrable materials as claimed.

8. As best understood view of the 112 matters above, claims 7-9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. (5775722) in view of Capdeville (5230730). Moore teaches a cover having a cylindrical outer housing 12 closed at the upper end of an upper housing cover 18, a conduit formed about the lower circumference of the outer housing near the entry of the orifice as shown in Figs. 2, and 3, and a retention means 38. Moore meets all claimed limitations except for the integral cap. Capdeville teaches that it is known in the art to provide a cap 46. It would have been obvious to one of ordinary skill in the art to provide a cap in the cover of Moore to provide an alternative attachment location.

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With respect to the dimension, it would have been obvious to one of ordinary skill in the art to make the cover in the claimed dimension, since such a modification would have involved a mere change in size and/or proportion. A change in size/proportion is generally recognized as being within the level of ordinary skill in the art. (see In re Rose, 105 USPQ 237 (CCPA 1955), and In re Tanczyn, 44 CCPA 704, 766, 241).

Furthermore, it would have been obvious to one of ordinary skill in the art to change the size of the cover in Moore to accommodate the desired content.

Regarding claim 11, it would have been obvious to one of ordinary skill in the art to make the cap in Capville out of metal to provide the desired property.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Moore rejection as set forth in paragraph 8, and further in view of Spector. The modified cover of Moore meets all claimed limitations except for spring clip. Spector teaches that it is known in the art to provide a spring clip 10. It would have been obvious to one of ordinary skill in the art to provide a spring clip in Moore as taught by Spector to close the bag easily.

10. As best understood view of the 112 matters above, claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. (5775722) in view of Doppelt (6506471), and further in view of Huang et al. (6287686). Moore teaches a cover having a cylindrical outer housing 12 closed at the upper end of an upper housing cover 18, a conduit formed about the lower circumference of the outer housing near the entry of the orifice as shown in Figs. 2, and 3, and a retention means 38. Moore meets all claimed limitations except for the fire-resistant material. Doppelt teaches that it is known in the art to provide a cover that is made from fire-resistant material (col. 2, lines 10). It would have been obvious to one of ordinary skill in the art

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to make the cover from fire-resistant material in Moore as taught by Doppelt to provide the desired properties for a cover.

Huang further teaches that it would have been obvious to one of ordinary skill in the art to make fire-resistant material from fire-resistant nylon (col. 3, lines 31). It would have been obvious to one of ordinary skill in the art to make the material from fire-resistant nylon in the modified cover of Moore as taught by Huang to provide the desired material/properties for the cover.

With respect to the dimension, it would have been obvious to one of ordinary skill in the art to make the cover in the claimed dimension, since such a modification would have involved a mere change in size and/or proportion. A change in size/proportion is generally recognized as being within the level of ordinary skill in the art. (see In re Rose, 105 USPQ 237 (CCPA 1955), and In re Tanczyn, 44 CCPA 704, 766, 241).

Furthermore, it would have been obvious to one of ordinary skill in the art to change the size of the cover in Moore to accommodate the desired content.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Moore rejection as set forth in paragraph 10, and further in view of Spector. The modified cover of Moore meets all claimed limitations except for spring clip. Spector teaches that it is known in the art to provide a spring clip 10. It would have been obvious to one of ordinary skill in the art to provide a spring clip in Moore as taught by Spector to close the bag easily.

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but they are not persuasive.

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With respect to the new matter, as set forth above, the original disclosure does not teach the cap being integral to the drawstring, and the internal volume comprising fire resistant nylon fiber.

With respect to the modification of the cover in Moore with respect to the size, modification with respect to sizing a cover requires only ordinary skill in the art. As set forth above, it would have been obvious to one of ordinary skill in the art to change the size of the cover in Moore to accommodate the desired content. Applicant specifically argues that the size is made to accommodate a torch. However, a torch is not being claimed. Furthermore, it is within commonsense to provide a cover protection for any objects, since it would prolong the life of the content, and this would include a torch. Furthermore, to modify a cover with respect to sizing, such as the cover in Moore is well within ordinary skill in the art and clearly within common sense.

Furthermore, a change in size/proportion is generally recognized as being within the level of ordinary skill in the art. (see In re Rose, 105 USPQ 237 (CCPA 1955), and In re Tanczyn, 44 CCPA 704, 766, 241).

With respect to the combination of Moore in view of Spector, applicant argues that the combination does not teach the claimed cover. However, applicant fails to point out exactly what is absent in the teachings of applied references. Clearly, Moore provides explicit suggestion to use such combination (col. 3, lines 64-66), i.e., “this fastener 38 can implemented with any conventional techniques”.

Arguments with respect to the newly added claims are moot in view of new grounds of rejections.

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Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

T. Mai
03/19/03